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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/297,895      | 06/30/1999  | EVA SEVICK-MURACA    | PCT-63/75P:U        | 1419             |

5073 7590 09/07/2006

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EXAMINER

ROSENBERGER, RICHARD A

ART UNIT PAPER NUMBER

2877

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/297,895

Applicant(s)

SEVICK-MURACA ET AL.

Examiner

Richard A. Rosenberger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-49 is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-7 is/are rejected.
- 7) ☐ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 May 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 08/25/2006.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1, 2, and 4-7 are rejected under 35 U.S.C. 101 because the steps of the method of independent claim 1 do not appear to be sufficient to produce a tangible result, since the outcome of the steps is not being claimed in a disclosed practical application nor is it outcome being made available in such a manner that its usefulness in a disclosed practical application can be realized. See OG Notices: 22 November 2005, "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility".

Claims 2 and 4-7, dependent from claim 1, are similarly rejected because none of these claims add to their parent claim the required practical application or make the outcome available in such a manner that its usefulness in a disclosed practical application can be realized.

3. Claim 3 adds the step of "controlling a process", which adds the "real world" application required to meet 36 USC 101 under the guidelines.

Independent method claims 19, 26, 32, and 45 all require "providing an output", which make the outcome made available in such a manner that its usefulness in a disclosed practical application can be realized, and thus meets the requirements of 35 USC 101 under the guidelines.

Independent system claims 8, 14, and 40 all embody the claimed material in a physical arrangement and thus do not set forth only an abstract idea, and thus meet the guidelines under 35 USC 101 under the guidelines.

The various dependent claims dependent from claims 8, 14, 19, 26, 32, 40, and 45 all meet the requirements of 35 USC 101 for the reasons of their respective parent claims.

4. Sato et al (US 4,497,577) shows related subject matter, including an iterative calculation of a size distribution ( $N(D)$ ); see in particular figure 5, box 508.

Sato does not appear to teach or suggest comparing values corresponding to isotropic scattering coefficients as in claim 1, but rather compares other values (see box 506).

The reference outputs a calculated value of wetness (from box 511), and does not appear to teach or suggest outputting information corresponding to the size distribution, volume fraction, and/or interaction parameter, as in claims 8, 14, 19, 26, 32, 40, and 45; as understood, the wetness of Sato et al, while calculable in part from the size distribution ( $N(D)$  in Sato et al), and in part from other information (see boxes 509m 510 and 511 if figure 5 of Sato et al), is sufficiently removed from the particle size distribution  $N(D)$  that the wetness cannot be reasonably taken as “corresponding to” the size distribution.

Thus claims 8-49 are allowable, and claim 3 contains allowable subject matter but is object to as being dependent from an unallowed parent claim, and would be

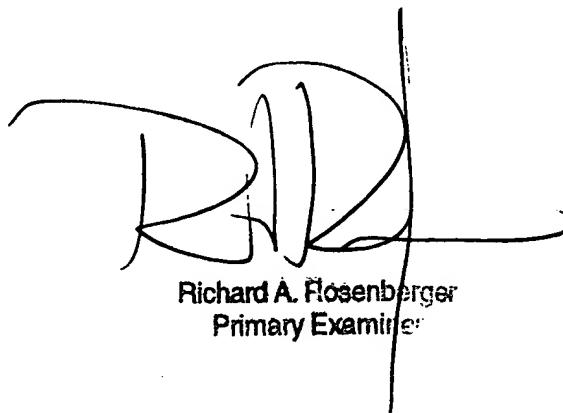
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allowable if rewritten in independent form including all of the limitations of its parent claim.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard A Rosenberger whose telephone number is (571) 272-2428. The examiner can normally be reached on Monday through Friday during the hours of 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr. can be reached on (571) 272-2800 ext. 77. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

R. A. Rosenberger  
29 August 2006



Richard A. Rosenberger  
Primary Examiner